

### **REMARKS**

This Amendment is in response to the Office Action mailed Feb. 5, 2009. Claims 1, 2, 4 – 10, 12, 15 – 19, 22, 24, 33 – 41 and 66 – 72 were pending and the Office Action rejected all the claims.

Specifically, Claims 1, 2, 4, 5, 7, 16 – 19, 22, 68 and 69 are rejected under 35 U.S.C 103(a) as being unpatentable over Brown (US 2003/0126850 A1) in view of Brown, et al (US 6298865), Garcia, Jr., et al (US 6626192) Tarantino, et al (US 2004/0187465 A1), Mitchell, et al (US 6112429), Cress, et al (US 6223502) and Levy, et al (US 5566695). Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to Claim 1, in further view of Herrerra (US 2003/0217650). Claims 8 – 10, 12 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to Claim 1 above, in further view of Hougham (US 5316778), Busta (US 3814820), Crossett (US 2666711), Bell et al. (US 1708253) and Alameda (US 5130152). Claim 24 was rejected in further view of Terry (US 5711980). Claims 33 – 36, 40 – 41, and 70 – 72 were rejected in further view of Hougham. Claim 37 was rejected under 35 U.S.C 103(a) in further view of Fox et al. (US 2644473). Claims 38 – 39 were rejected under 35 U.S.C 103(a) as being unpatentable over the references applied to Claims 33 – 36, 40 – 41, 70 – 72, and in further view of Hougham, Busta, Crossett, Bell et al. and Alameda.

In addition, Claims 1, 2, 4, 5, 7 – 10, 12, 15, 16 – 17, 18, 19, 22, 33 – 41 and 66 – 72 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. (US 6112429) in view of Hougham (US 6298865), Garcia Jr. et al. (US 6626192) and Tarantino et al. (US 2004/0187465). Cress et al. (US 6223502) and Levey et al. (US 5566695) have been relied on as evidence. Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to 1, 2, 4, 5, 7 – 10, 12, 15, 16 – 17, 18, 19, 22, 33 – 41 and 66 – 72 above,

in further view of Hererra (US 2003/0217650). Claim 24 was rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above, in further view of Terry (US 5711980).

#### Impermissible Hindsight Reconstruction

While the Office Action admits that the present claims are not anticipated by any of the numerous cited references, the Office Action has combined these numerous references for supporting various obviousness rejections. More particularly, the Office Action has cited a total of 15 references, in various combinations, to attempt to argue that the pending claims are obvious under 35 U.S.C. 103(a). However, the Office Action is based entirely on hindsight reconstruction using the Applicants' teachings and claims as a guide. The Federal Circuit has repeatedly held such a rejection is improper.

The Applicants are aware of the recent U.S. Supreme Court decision in *KSR v. Teleflex*, 550 U.S. 398 (2007), holding that the combinations of known elements can be found to be obvious, where there is no inventive skill required to make the combination. The KSR decision may have effectively weakened the prior "Teaching, Suggestion, Motivation" (TSM) standard. However, nothing in this decision appears to overturn the long-standing rule prohibiting hindsight reconstruction. In other words, using the Applicants' own teachings and claims as a guide to combine random elements found in the prior art is still prohibited. The Federal Circuit has recently noted:

"We are mindful that in KSR, the Supreme Court made clear that a finding of teaching, suggestion, or motivation to combine is not a "rigid rule that limits the obviousness inquiry." 127 S.Ct. at 1741. This, however, does not alter the district court's pre-KSR conclusion in this case or our affirmance thereof. There was a complete absence of any proof that one skilled in the art would find the particular claimed method obvious based upon Dr. Patterson's list of prior art references or the knowledge generally available to those of ordinary skill in the art for any reason. We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed

invention. Although Abbott cites KSR, it does not argue on appeal that a different result would be reached in this case under KSR.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

In addition, the Board of Patent Appeals and Interferences (BPAI) has similarly warned against reliance on KSR to undermine that long standing prohibition against hindsight reconstruction.

“While the analysis under 35 U.S.C. § 103 allows flexibility in determining whether a claimed invention would have been obvious, *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it still requires showing that “there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* “We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).”

*Ex Parte Williams et al.*, Appeal No. 2009-000497 (BPAI Jul. 14, 2009).

“ “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). See also *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art”). The Examiner has not provided the required articulated reasoning with rational underpinning but, rather, appears to have rejected the Appellants’ claims based upon impermissible hindsight in view of the Appellants’ disclosure.”

*Ex Parte Ertel et al.*, Appeal No. 2009-1337 (Apr. 29, 2009).

It is undisputed that despite an extensive prior art record, the Office Action has failed to articulate, with rational underpinnings, why one of skill in the art would be able to view of the cited prior and know how to combine them without reliance on the Applicants’ teachings. One of skill in the art would have to not only figure out which elements to combine, but also which

elements, among the vast number in the prior references, should NOT be combined. The Patent Office is not permitted to use the Applicants' claims as "shopping list" into the prior art elements.

### Prior Art Rejections

In any event, the cited combination of references fails to disclose the present invention as claimed. Even under the KSR decision, to establish a *prima facie* case of obviousness, each and every element of a claim must still be found in the prior art. For the reasons set forth below, the cited prior art fails to disclose certain of the present limitations. The main references relied on by the Examiner, as understood by the Applicants, are specifically discussed below.

### **Brown I (U.S. 20030126850)**

The Brown reference fails to disclose that the de-cored produce are arranged in any particular order in the totes. Also, since the products are later sprayed with water from "above and below" (para. [0043]), there is no disclosure that the washing fluid necessarily flows from the de-cored end to an opposite end. Furthermore, the Brown reference fails to disclose using a washing tank as claimed in Claims 1, 33 and 69.

The Examiner seems to equate spraying water from both the top and the bottom as teaching the washing fluid necessarily flows from the de-cored end to an opposite end, since at least one set of nozzles would necessarily be spraying in the correct direction. However, the Brown reference must be taken as a whole, and there is nothing in it to suggest which set of nozzles (the upper or lower) could be removed. The Brown reference also actually teaches away from the present invention by failing to disclose the need/desire for a wash tank (i.e. Claim 1, 33 and 69) and instead teaching that spraying the produce is sufficient.

### **Mitchell**

As understood by the Applicants, Mitchell fails to disclose placing de-cored products into a tote, and aligning the de-cord ends against a side of the tote. As clearly shown in Fig. 2B of Mitchell reference, the core ends (the ends are not even “de-cored” ends) are placed towards the center of the tote, facing each other in two rows. In contrast, as shown in Figs. 6(A) and 6(B) of the present application, the de-cored ends are placed against the side of the tote (either in one or two rows as shown in the figures).

Moreover, since the products of Mitchell are not cored, the washing fluid cannot flow through the “de-cored ends” of the products.

Again, in order to “create” relevance for this reference, the Examiner has merely conveniently selected certain aspects of the reference, and ignored others.

### **Garcia**

As understood by the Applicants, Garcia similarly fails to disclose placing totes in a washing fluid. Merely spraying the produce is not the same as specifically placing the produce in a washing fluid such that the washing fluid flows through the de-cored ends.

Clearly, Garcia fails to disclose the specific limitations of the present Claims.

### **Hougham**

The Hougham reference is directed to a technique whereby leafy vegetables have their leaves torn from the vegetable stems, and then the leaves are sorted into separate baskets. The separated leaves are then washed.

Hougham utterly fails to provide any disclosure to support the rejection of the present claims. In fact, most of the citations for support of the rejection do not make sense. For example, what is a “de-cored” end of a leaf, such that the fluid flow is directed to the de-cored end? The baskets are clearly not “totes”, de-cored products are not arranged in any particular order, and the washing fluid does not pass through the product in any particular direction.

The addition of the Brown II, Tarantino, Cress, Levy, Hererra, Busta, Crosett, Bell, Alameda, Fox and /or Terry references do not overcome the deficiencies of the other references, as they similarly fail to disclose the specific limitations of independent Claims 1, 33, 69 and 70.

A key failing of the combinations cited by the Office Action is that, taken as a whole, the references do not teach arranging the de-cored produce in a specific direction in totes, such that when immersed in wash tanks, the washing fluid can flow in a specific direction through the produce. These references do not disclose arranging the de-cored products in such a way that the de-cored ends face against a side of the tote. Nor do these references disclose that the washing fluid is specifically directed to flow through the de-cored end. Therefore, these references clearly do not anticipate the present claims. Since none of the references have the noted limitations, simply combining them (even using impermissible hindsight reconstruction) does not provide a disclosure of the specific limitations of the present claims.

Despite the citation and combination of 15 different references, the Office Action has failed to provide a specific citation to a reference which loads de-cored products into a tote with

the de-cored edges facing against a side of the tote, and directing the washing fluid through the de-cored end. This factor alone tends to show that the present invention is not obvious in view of the prior art. Additional limitations not disclosed include conveying the tote through a wash tank with the de-cored ends in the direction of conveyance. Moreover, the references fail to disclose loading the de-cored products into two rows, with the de-cored ends facing the sides of tote.

#### Response to Examiner's "Response to Arguments"

##### Paragraphs 17 and 22

In paragraph 17 of the Office Action, the Examiner argues that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." However, this is exactly the problem with the Examiner's rejections – they are based on selecting individual elements from a multitude of references without support for WHY such a combination would, in fact, be obvious. The patent office cannot have it both ways – select individual elements from different references to show obviousness, while objecting to arguments which point out the problems with each reference, when taken as a whole (i.e. teaching away, etc.).

The remaining arguments are addressed above with respect to the specific references.

It is thus believed that the present claims are now in condition for allowance. If the Examiner believes that a telephone conference would expedite this application, the Examiner is encouraged to telephone the undersigned attorney at the number listed below.


The Commissioner is hereby authorized to charge any fees (or credit any overpayment) associated with this communication and which may be required under 37 CFR §1.78 to Deposit Account No. 50-2603, **referencing Attorney Docket No. 351606.00500.**

Respectfully submitted,

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